

REMARKS**Status of the Claims**

Claims 14, 33-34, 56, 67, 118-119, and 122-139 were presented for examination, and were variously rejected.

Claims 14, 33-34, 56, 67 and 118-119 have been canceled by this amendment.

Claim 122 was amended to remove language about ‘comprising a magnetic material’, which appears redundant in view of the language saying the microdevice comprises a ‘patterned magnetic material.’ In addition, claim 122 has been amended to say that the binding partner is ‘on a surface of the microdevice.’ Claim 127 has been amended to describe certain embodiments of the invention of claim 122. Claim 128 has been amended to refer to a magnetic alloy, rather than a magnetic material; this is supported by, for example, the top two lines of page 21 of the application.

New claims 140-143 have been added. Claim 140 is supported by, for example, the first full paragraph on page 21 of the application. Claim 141 is supported by this plus the preceding paragraph, which discloses an embodiment wherein the magnetic material and photorecognizable coding pattern are separate encoding layers, as well as by the description beginning in the last paragraph on page 77 and continuing through the end of page 79, which describes making such embodiments. Claims 142-143 are supported by the paragraph on page 21, beginning at line 11, which describes devices having orientation markers for determining which surface of the microdevice is ‘up’. The amendments are supported by the specification as discussed herein, and add no new matter. Entry of the amendments, and reconsideration in view of the remarks herein, are respectfully requested.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 122-132 were said to be allowable but for certain limitations alleged by the Examiner to be indefinite. First, the Examiner requested clarification of the relationship between

the binding partner and microdevice, saying it appears that the binding partner is immobilized on the substrate.

Claim 122 has been amended to say the binding partner is on a surface of the microdevice. This is supported by the specification in the paragraph starting at line 15 of page 22, which says the binding partner is ‘coupled on’ the microdevice; and by the following paragraph on that page, which says the binding partner is “immobilized on the microdevices’ surfaces.” In view of the amendment, this rejection can be withdrawn.

Second, the Examiner asks whether the ‘photorecognizable pattern’ is the same as the ‘patterned magnetic material’. The Examiner points to Figure 13 and indicates that it appears to show that the magnetic material corresponds to the photorecognizable holes. Indeed, Figure 13 provides support for certain embodiments of the claimed invention. The associated description for Figure 13 includes discussion starting in the last paragraph of page 77 and the following pages, which describe producing multiple layers, each of which can be patterned. At the top of page 78, it describes a patterned middle layer that can be a magnetic material. However, at the top of page 21, the specification also says the photorecognizable pattern can be a separate layer from the magnetic material. It says the photorecognizable coding pattern can be an encoding layer, separate from the magnetic layer; this is the basis for amended claim 127. The first new paragraph on page 21 then says the microdevice can comprise “a plurality of photorecognizable coding patterns, e.g., a plurality of the holes and/or a plurality of the substances.” Thus the photorecognizable pattern may correspond to the magnetic material, or the magnetic material can be a separate layer. This is believed to be consistent with the claim language as presented, which separately requires a ‘patterned magnetic material’ and a ‘photorecognizable coding pattern.’ The claim clearly provides these as two required features, but does not require them to be either the same item or separate items. Claim 125 says the patterned magnetic material “is an encoding material” and thus permits the patterned magnetic material to correspond to the photorecognizable coding pattern, though it also permits the patterned magnetic material to provide a separate encoding feature. Because the specification describes both alternatives, the claims should not be limited to either one; accordingly, no claim amendment is needed to address this rejection. Reconsideration of the rejection is respectfully requested, and withdrawal of the rejection is believed to be appropriate.

In view of this, claims 122-132 are believed to be clear to a reader of ordinary skill, and as indicated by the Examiner, they are believed to be patentable over the prior art. New claims 140-143 depend from these claims, and add additional limitations taken from the specification, so they too are believed to be patentable over the art of record.

Rejection Under 35 U.S.C. § 103

Claims 14, 33-34, 56, 67, 118-119, 133-139 were rejected as allegedly obvious. Claims 14, 33-34, 56, 67, and 118-119 have been withdrawn.

Claims 133-139 require a binding partner that comprises 'a cell, a cellular organelle, a virus, or an antibody'. The rejection with respect to the 'binding partner' claim limitation relies upon the Examiner's allegation that Kaye, et al. discloses target molecules immobilized on the microdevice, including peptides, compounds or oligonucleotides suitable for combinatorial synthesis or analysis.' The Examiner alleges these are 'inherently' binding partners. However, none of these correspond to the binding partners required by claim 133. Moreover, the binding partners in claim 133 are not 'suitable for combinatorial synthesis.' Kaye's disclosure of the possibility that combinatorial libraries could be synthesized on its microdevice does not disclose or suggest any of the binding partners of claim 133: they could not be synthesized by routine combinatorial methods. Thus the obviousness rejection of claim 133 and its dependent claims is overcome, and should be withdrawn.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and

authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 471842000500.

Dated: February 3, 2008

Respectfully submitted,

By: _____ / Michael G. Smith / _____

Michael G. Smith

Registration No.: 44,422

MORRISON & FOERSTER LLP

12531 High Bluff Drive, Suite 100

San Diego, California 92130-2040

(858) 720-5113